

**PATENT APPLICATION**

**RESPONSE AFTER FINAL REJECTION  
EXPEDITED PROCEDURE  
TECHNOLOGY CENTER ART UNIT 3714**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Satoru OUCHI

Group Art Unit: 3714

Application No.: 09/937,777

Examiner: J. HOTALING

Filed: October 1, 2001

Docket No.: 110700

For: GAME APPARATUS, STORAGE MEDIUM, TRANSMISSION MEDIUM AND  
COMPUTER PROGRAM

**REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In reply to the May 11, 2006 Office Action, reconsideration of the rejections is respectfully requested in light of the following remarks.

Claims 31-33, 35-39, 51-53 and 56-58 are pending.

Applicant appreciates the courtesies shown to Applicant's representative by Examiner Hotaling in the July 25 personal interview. Applicant's separate record of the substance of the interview is incorporated into the following remarks.

**I. Claims 32, 33, 52, 53, 57 and 58 Satisfy  
the Requirements of 35 U.S.C. §112, First Paragraph**

The Office Action rejects claims 32, 33, 52, 53, 57 and 58 under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement. This rejection is

respectfully traversed, and it submitted that claims 32, 33, 52, 53, 57 and 58 satisfy the requirements of 35 U.S.C. §112, first paragraph.

To satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed (see *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ 2d 1111, 1117 (Fed. Cir. 1991)) An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention (see *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997)) (emphasis added). Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was “ready for patenting” such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention (see, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S. Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998)).

Claims 32, 52 and 57 recite that the second generating code extracts the game image data corresponding to the normal screen from the game image data generated by the first generating code such that the game image data corresponding to the normal screen has an area, between one end of the normal screen and the character, that is larger than an area, between an other end of the normal screen and the character, based on the moving direction or an eyes direction of the character in the game image data generated by the first generating section.

As asserted during the personal interview, the specification and figures fully support these claimed features to show that the Applicant had possession of this feature at the time of

filings of the instant application. For example, as shown in Fig. 5B, the area between the character and the right end of the screen is larger than the area between the character and the left end of the screen. That is, the area of the normal image data may be generated so as to have a larger right range of vision than the left range of vision based on, for example, the moving direction of the moving object (see specification at pg. 20, line 18 - pg. 21, line 18). Thus, one of ordinary skill in the art would reasonably conclude that the Applicant had possession of the claimed invention at the time of the application filing.

For at least these reasons discussed above and during the personal interview, claims 32, 52 and 57, and claims 33 and 58, depending therefrom, satisfy the requirements of 35 U.S.C. §112, first paragraph. Withdrawal of the rejection is thus respectfully requested.

## **II. The Claims Define Patentable Subject Matter**

The Office Action rejects claims 31-33, 35-39, 51-53 and 56-58 under 35 U.S.C. §103(a) over U.S. Patent No. 5,249,049 to Kranawetter et al. (Kranawetter) in view of U.S. Patent No. 5,045,939 to Okayama and further in view of U.S. Patent No. 6,331,146 to Miyamoto. This rejection is respectfully traversed.

Claims 31-33, 35-39, 51-53 and 56-58 would not have been rendered obvious by Kranawetter in view of Okayama and further in view of Miyamoto. As asserted during the personal interview, none of the applied references teaches or suggests a game apparatus, a computer-readable storage medium or a transmission medium that includes "a first generating section for generating game image data of the game space corresponding to a wide screen" and "a second generating section for extracting an area based on a moving direction or an eyes direction of the character in the game image data as game image data corresponding to a normal screen, from the game image data generated by the first generating section ...," as recited in independent claim 31, and as similarly recited in independent claims 51 and 56 (emphasis added). That is, as asserted during the personal interview, none of the applied

references teaches or suggests generating the game image data corresponding to a wide screen first (the claimed first generating section), and then extracting an area (based on a moving direction or an eyes direction of the character) in the game image data as game image data corresponding to a normal screen, from the game image data generated by the first generating section, second (the claimed second generating section), as recited in the independent claims 31, 51 and 56.

Kranawetter only relates to television receivers having a viewing area with a particular display format ratio or aspect ratio that includes a controller for determining the active video portion of a signal and adaptively displaying the active video portion as to make full use of the vertical view area (see Kranawetter at col. 1, lines 7-12). Kranawetter only relates to adjusting format display ratios of inputted video signals (see Kranawetter at Abstract). For example, Kranawetter merely discloses horizontally cropping the source with aspect ratios greater than 16:9 and displaying sidebars when the ratio is less than 16:9 (see Kranawetter at col. 6, lines 44-62). Further, nowhere does Kranawetter disclose generating game image data. Thus, Kranawetter does not disclose generating game image data of the game space corresponding to a wide screen, as recited in the independent claims.

Further, Miyamoto and Okayama do not remedy the deficiencies of Kranawetter. Miyamoto is cited by the Office Action for only its alleged teaching of movement of a character in a game space, and Okayama is cited by the Office Action for only its alleged teaching of a second generating section.

However, Okayama does not teach or suggest "a second generating section for extracting an area based on a moving direction or an eyes direction of the character in the game image data as game image data corresponding to a normal screen, from the game image data generated by the first generating section . . . ," as recited in independent claim 31, and as similarly recited in independent claims 51 and 56 (emphasis added). That is, the area

according to the right and left operation of the moving object controlled by the player is extracted from the game image data generated for a wide screen.

Okayama only discloses extracting a part of a wide screen television signal based on which part of the wide screen signal has the greatest amount of motion within the wide screen television signal (see Okayama at col. 2, lines 18-29). That is, the area in which the average value of the motion values is the maximum is the area to be extracted as the normal screen television picture (see Okayama at col. 6, lines 21-24). Okayama is merely converting television signals, and not generating game image data. Thus, Okayama does not disclose extracting an area based on a moving direction or an eyes direction of the character in the game image data as game image data corresponding to a normal screen from the game image data generated by the first generating section, as recited in independent claims 31, 51 and 56.

Finally, there is no motivation to combine Kranawetter, Miyamoto and Okayama. It is impermissible for an Examiner to engage in hindsight reconstruction of the prior art using Applicant's claims as a template and selecting elements from references to fill the page. The references themselves must provide some teaching whereby the claimed combination would have been obvious (see, e.g., *In re Gorman*, 911 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir, 1991)). That is, something in the prior art as a whole must suggest the desirability, and thus obviousness, of making the combination (see, e.g., *In re Beattie*, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)). He or she may not, because he or she doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis (see, e.g., *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968)).

There is no teaching or suggestion to combine Kranawetter, Miyamoto and Okayama, and thus the Office Action relies on improper hindsight reasoning to achieve the claimed invention.

Thus, for at least these reasons discussed above, and during the personal interview, independent claims 31, 51 and 56 are patentable over Kranawetter, Miyamoto and Okayama. Further, claims 32-33, 35-39, 52-53, 57 and 58, which variously depend claims 31, 51 and 56, are also patentable for at least the reasons discussed above, as well as for the additional features they recite. Withdrawal of the rejection is thus respectfully requested.

**III. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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